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EXAMINER

LONEY, DONALD J

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 10/23/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/717533

Applicant(s)

Malpers et al

Examiner

D. Loney

Group Art Unit

1722

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on June 30, 2003
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1, 2, 4-13 and 16-20 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1, 2, 4-13 and 16-20 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

2.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1,4,6,7,16,17 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Heine as presented in the last office action mailed January 28, 2003.

Heine teaches a product with two layers (11 and 12) that has cylindrical recessions (13) in the bottom. Refer to Fig. No. 3. The product by process claims are included within this rejection, and will be in all others including claim 1, since it is the patentability of the product that is in issue, not the patentability of the process steps employed to prepare the product. See in re Fessmann, 180 USPQ 324 and In re Brown, 173 USPQ 685. Claim 20 is included since the first and second diameters are recited as different.

4. Claims 1,2,4,16 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Corson as presented in the last office action mailed January 28, 2003.

Corson teaches a rubber mat with recessions that are round which form cylindrical recessions. Refer to Fig. Nos.8 and 9 along with column 2, lines 43-47.

5. Claims 1,2,4,6,8,13,16,17,18 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Shiner as presented in the last office action mailed January 28, 2003.

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Shiner teaches a multiplayer rubber mat wherein the bottom layer (either layer 7) has cylindrical recessions since they take the form of the two different sized holes (3 and 5). Refer to Fig.Nos.1 and 2 along with the corresponding text. The mat may also contain antibacterial materials. Refer to page 2, column 1, lines 6-8.

6. Claims 1,2,5,6,8,16 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Tesch as presented in the last office action mailed January 28, 2003.

Tesch teaches a mat with a fabric layer (2) and a backing layer (7) that has cylindrical recessions therein. Refer to Fig. Nos. 2 align with column 9, lines 14-16.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained through the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject pertains. Patentability shall not be negative by the manner in which the invention was made.

8. Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiner or Tesch as presented in the last office action mailed January 28, 2003.

The primary references fail to teach the variety of rubbers and two different harnesses.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to the primary references to use a mixture of rubbers, since in recycling a variety of rubbers are usually mixed to form new products for the composite layers. It would also be obvious to form the lower layer of a softer material in order to

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provide a better cushioning effect. The top layer usually needs to be tougher since it is subject to repeated direct contact.

9. Applicant's arguments filed June 30, 2003 have been fully considered but they are not persuasive.

10. In response to applicant's argument that the cylindrical recessions of the recited invention are operative to reduce movement of the layer with respect to all of the above rejections, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

As indicated above all of the references teach a layer with cylindrical recessions in one side.

The applicant also argues that Heine fills the holes therefore none would be cylindrical, however on intermediate product (i.e. Fig. No. 3) can still read upon the recited invention. Also, Heine shows the holes as having the same shape even after coating them (i.e. they are not completely filled). See Fig. No. 4.

The applicant argues Corson fails to teach a cylindrical recession in the mat. However 17a is disclosed as a recess that is round. See column 2, line 43-49. The applicant also argues that Corson teaches the recesses on the top surface. However

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this is relative to which side one is looking at in reference to top or bottom surface and does not structurally distinguish from the prior art.

The applicant argues *Tesch* fills the recessions, however, before filling thereof the intermediate product would structurally read upon the reacted invention. *Tesch* shows a backing sheet (1) with a molded sheet (7) that has cylindrical recessions (8) therein as rejected.

The applicant argues that *Shiner* teaches a truncated cone for the recession. This is nearly a tapered cylindrical recession and still reads upon the structure reacted.

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1, 2 and 4 are rejected under 35 U.S.C. 102(e) as being anticipated by Wang et al.

Wang et al teaches a mat with cylindrical recessions formed in the bottom surface. Refer to Fig. No. 5 element 421 along with column 2, lines 40-47.

13. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

14. Claims 1,2,4-13 and 16-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of copending Application No. 10/132,008. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both recite a mat with cylindrical recessions (i.e. original claim 5).

The examiner has included the publication of serial number 10/132008. The file is currently unavailable to the examiner since it is an allowed file in Publication Branch.

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication should be directed to Ex. D Loney at telephone number 703 308-2416.


DONALD J. LONEY
PRIMARY EXAMINER

D. Loney/lap

October 8, 2003